REMARKS

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claims 1, 3, 4, 6-8, 10-13, 16, and 17 have been amended as shown above.

Claims 21 and 22 have been added.

Claims 1-22 are now pending in this application.

Reconsideration and full allowance of Claims 1-22 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-8, 10, and 12-20 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,785,399 to Fujihara ("*Fujihara*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP § 2131; In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)*). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP § 2131; In re Donohue, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)*).

Fujihara recites a system where a transmitting device inserts "specified datum" as a watermark into data representing an image. (*Abstract*). The "specified datum" represents a process

to be performed by a receiving device that receives the image data. (*Abstract*). In particular, the receiving device of *Fujihara* receives, demodulates, and displays the image data on a CRT display device. (*Col. 3, Lines 1-14*). In parallel with the displaying, the demodulated data is also examined to identify a watermark, the specified datum is identified in the watermark, and the process associated with the specified datum is performed. (*Col. 3, Lines 15-43*).

Fujihara simply recites a system where data is demodulated and the same demodulated data is displayed and examined to identify a process to be performed. However, the identification of the process to be performed does not rely on the output of the CRT display device in *Fujihara*. Rather, the identification of the process to be performed relies on the demodulated data, which is input to the CRT display device.

In contrast, Claims 1, 6-8, 10, 12, 13, and 17 have been amended to recite that a "controllable device" receives a rendered signal that is produced by at least one of (i) a "video device" or "video means" and (ii) an "audio device" or "audio means." *Fujihara* lacks any mention that a rendered signal is used to control a device. For example, *Fujihara* lacks any mention that the output of the CRT display device is used to control a device. As a result, *Fujihara* fails to anticipate all elements of Claims 1, 6-8, 10, 12, 13, and 17.

For these reasons, *Fujihara* fails to anticipate the Applicants' invention as recited in Claims 1, 6-8, 10, 12, 13, and 17 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the §102 rejection and full allowance of Claims 1-8, 10, and 12-20.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Fujihara* in view of U.S. Patent No. 6,829,710 to Venkatesan et al. ("*Venkatesan*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

Claim 9 depends from Claim 1, and Claim 11 depends from Claim 10. As described above in Section I, Claims 1 and 10 are patentable. As a result, Claims 9 and 11 are patentable due to their dependence from allowable base claims.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 9 and 11.

III. NEW CLAIMS

The Applicants have added new Claims 21 and 22. The Applicants respectfully submit that no new matter has been added. At a minimum, the Applicants respectfully submit that Claims 21 and 22 are patentable due to their dependence from allowable base claims. The Applicants respectfully request entry and full allowance of Claims 21 and 22.

IV. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition

for allowance and respectfully request full allowance of the claims.

SUMMARY

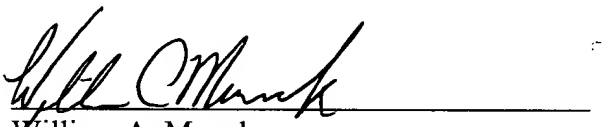
If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicants have included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fee) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: JUNE 22, 2005



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